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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/193,787

**Applicant(s)**

DRUMMOND ET AL.

**Examiner**

Jalatee Worjloh

**Art Unit**

3621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the Appeal Brief filed on December 28, 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing this Office Action.

***Response to Arguments***

2. Applicant's arguments filed 12-28-07 have been fully considered but they are not persuasive.

3. Appellants assert that the Board "fully considered claim 12 in the decision rendered October 8, 2003" and that the rejection of claim 12 was reversed. Also, Appellants' note that "nowhere in the decision did the Board imply that claim 12 was a single means claim. Nowhere in the decision did the Board imply that Appellants' application did not meet the requirements of 35 U.S.C. § 112, first paragraph".

In response, the Examiner notes that the Board renders decisions based on the issues presented. However, if desire, the Board may introduce new grounds of rejection, but is not required to do so (see 37 CFR 41.50).

**The Rejection Under 35 U.S.C. §112, First Paragraph**

4. Appellants argue that the Office cannot rely upon *In re Hyatt* because it relates to “a claim having a means-plus-function format. Claim 12 does not include a means-plus-function format”.

Notice, the single means rejection of claim 12 does not solely rely on *In re Hyatt*. Hyatt has the principle of a “single means” rejection. Other decisions have expanded the principle to apply to claims that did not literally use means plus function language, but were analogous.

5. Appellants argue, “there is nothing wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.”

The Examiner agrees that there is “nothing wrong” with functional language and “means plus function” language; however, there is a problem when a claim recites only one means or one function.

6. Appellants argue they are “not required to recite apparatus structure at the atomic level” and that the “Office’s own patent classification system recognizes an “ATM” (e.g., class/subclass 70/43)”.

The Examiner notes that the Office is not requesting Appellants to recite the structure at the “atomic level”. Also, U.S. classification is no guide to proper claim construction or interpretation.

7. Appellants assert that claim 12 is limited to an ATM structure.

However, claim 12 does not have a structure it is only functional language, which is traditionally viewed as any structure capable of doing the recited function. Thus, this is even broader than means plus function language since we are not limited by Donaldson and MPEP 2181 to corresponding structure in the specification plus equivalents. Appellants also describe numerous structural elements in the single mention of ATM in the preamble, which are not expressed. Thus, if Appellants believe that these structural elements are there, it is suggested that they are positively identified and claim.

8. Appellants state that they are not attempting "to cover all ATMs" with claim 12.

However, this is not the issue. The issue is covering all ATMs that do the recited function even ones beyond what are in the specification. As recited in MPEP Sec MPEP 2164.08(a), "A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor".

9. Appellants' further discussion of Hyatt merely focuses on the lack of "means" and insists ATM requires specific structure. This specific structure is not in the claim. Nor is any specific structure identified in a "special definition" in the specification. For example, the page 1 of the

specification states, "an automated banking machine or automated transaction machine shall encompass any device which carries out transactions including transfers of value".

10. Appellants argue that Fiers v. Sugano case is non analogous and that it relates to award of invention priority in an interference.

Although, this case relates to interference, the comments of the court are directed to the interference count, which is a claim. The court clearly states "Because the count at issue purports to cover all DNAs that code for b-IF, it is also analogous to a single means claim, which has been held not to comply with the first paragraph of section 112. See *In re Hyatt*". This count did not use "means plus function language", here's the count - "A DNA which consists essentially of a DNA which codes for a human fibroblast interferon-beta polypeptide." Given applicant's definition in the specification about "any device which carries out transaction functions", this fits the what is going on in Fiers.

11. Appellants also argue that Maizel is nonanalogous.

The Examiner respectfully disagrees. The claim does read, as Maizel's did, on any structure that could achieve the stated function, and thus it is analogous to a single means claim and must be rejected. Appellants recycle the same arguments for Kung, but the same results remain, applicant's claim 12 is directed to any and every structure that can achieve the stated result. There is no "specific class of structure" as argued by Appellants with respect to Kung in light of his definition in the spec and the absence of "means" language is not determinative.

**The Rejection Under 35 U.S.C. § 103 (a)**

**Wagner is non-enabling**

12. Appellants argue that “Wagner’s use of the term ‘non-standard I/O device’ is vague and indefinite, and renders the disclosure non-enabling.” Particularly, Appellants assert that Wagner devices or either input devices or output devices not both.

However, the Examiner respectfully disagrees. Wagner describes the non-standard I/O device as a screen phone terminal, a personal digital assistance, a credit card terminal, smart card reader, personal identification number pad, magnetic card swipe reader, printer, or the like (see col. 9, lines 55-67 and col. 10, lines 1-9). This description clearly identifies the elements that are considered a non-standard I/O device. The Examiner also notes that the phrase “input/output” does not require both elements to be combined, but instead implies that either input or output is included, which is denoted by the “/” punctuation.

Further, in applying the test of enablement to Wagner, undue experimentation is not needed.

**Wagner’s Teaching is limited to the level of ordinary skill in 1995**

13. Appellants argue that “Wagner’s teaching with regard to technology is limited to the early 1995 time period.” Also, Appellants asserts that the Office applied today’s level of one having ordinary skill in the art to the teaching of Wagner.

The Examiner respectfully disagrees. Wagner teaches merchants using a web server to communicate with non-standard I/O devices and a processing system. A client program initiates a transaction by interpreting HTML files containing HTML commands/tags to communicate data between non-standard I/O devices and the server. These tags are used to identify device transfers and input operations. For instance, “the FORM tag is used to identify device transfers and ACTION and METHOD attributes further identify the device operation. As shown in Fig. 2 the

extended ACTION field may include a FROM and TO attribute for accessing a local terminal file or smart card reader or a TO PRINTER attribute for directing output data to a printer local to the I/O device...As a result, the server 12 may access non-standard I/O peripherals for any of the I/O devices used in the transaction or data system." (See at least col. 10, lines 5-9 and line 66, 67; col. 11, lines 1-67). As for financial transactions, other commands are taught by Wagner, such as the PAYMENT attribute, "this directive is used by the client program to activate a conventional financial transaction application which communicates with the transaction application which communicates with the transaction system over a dedicated data line or PSTN in a known protocol such as VISA." Also, an ATM tag is implemented for "reading an integer via a key input mask"(see col. 11, lines 55-24). Thus, the HTML tags cause the I/O device to perform financial transaction. As expressed in the Office Action and as supported by Wagner, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to cure the deficiencies of Morioka by utilizing the technology of Wagner.

**Claim 12 is not obvious over Morioka in view of Wagner**

14. Appellants argue that Wagner does not teach "an ATM that operates to conduct at least one financial transaction responsive to at least one mark-up language document." In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, Appellants assert that Wagner "teaches away from conducting a financial transaction responsive to a mark-up language document". The Examiner respectfully disagrees.



### ***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6965879 to Richards et al. (“Richards”).

Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses an automated teller machine (i.e. an automated banking machine) that operates to conduct at least one financial transaction responsive to at least one mark-up language document (i.e. the machine is operative to carry out note dispensing transactions responsive to markup language documents). However, claim 1 of Richards differs since it recites an additional element, which indicates that the machine dispenses note responsive to receipt of non-HTTP messages. Since the claim recited in Richards and the present invention performs a similar function, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of

Richards by removing the additional element. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

17. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6965879 to Richards et al. ("Richards"). Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses an automated teller machine (i.e. an automated banking machine) that operates to conduct at least one financial transaction responsive to at least one mark-up language document (i.e. wherein the computer is adapted to operate responsive to at least one markup language document to control at least one markup language document to control at least one of the display device or the note dispenser mechanism). However, claim 3 of Richards differs since it recites an additional limitations including "a display device, a note dispenser mechanism is adapted to selectively dispense notes from the banking machine, a server, wherein at least one markup language document is accessible through the server, at least one computer in operative connection with the display device and the note dispenser mechanism, the at least one computer including software executable therein, the software including a Browser, wherein the browser is operative to communicate with the server, wherein the at least one computer is adapted to receive markup language documents with the browser". However, it is known in the art that an automated banking machine includes a display device, a note dispenser that is adapted to selectively dispense notes from the banking machine. Also, it would have been obvious to a

person of ordinary skill in the art to modify Richards by removing the additional features because the present invention and claim 3 of Richards performs a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

18. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6965879 to Richards et al. ("Richards"). Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses an automated teller machine (i.e. an automated banking machine) that operates to conduct at least one financial transaction responsive to at least one mark-up language document (i.e. operating the computer responsive to the at least one markup language to cause at least one of an output to be displayed or a note to be dispensed from the banking machine). However, claim 4 of Richards differs since it recites an additional limitations (see steps (a) - However, it is known in the art that an automated banking machine includes a display device, a note dispenser that is adapted to selectively dispense notes from the banking machine. Also, it would have been obvious to a person of ordinary skill in the art to modify Richards by removing the additional features because the present invention and claim 3 of Richards performs a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus,

omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

19. Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6965879 to Richards et al. ("Richards"). Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses an automated teller machine including: an output device (note dispenser or display device), wherein the output device outputs information, an input device (display device), wherein the input device is operative to receive inputs, a transaction function device, wherein the transaction function device (note dispenser) is selectively operative to carry out a transaction function, a computer, wherein the computer is in operative connection with the output device, the input device and the transaction function device (at least one computer in operative connection with the display device and the note dispenser mechanism), software executable in the computer, wherein the browser is operative to process HTML documents including instructions therein (markup language), and wherein the transaction function device is operative to carry out the transaction function responsive to the browser processing at least one document including at least one instruction adapted to cause the computer to cause operation of the transaction function device (wherein the at least one computer is adapted to operate responsive to at least one markup language document to control at least one of the display device or the note dispenser mechanism), wherein the transaction function device includes a sheet dispenser (note dispenser).

20. Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6965879 to Richards et al. ("Richards")

Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses an automated teller machine (an automated banking machine) comprising a computer, a browser operating in the computer, a transaction function device (note dispenser) in operative connection with the computer, wherein the computer is operative to cause the transaction function device to carry out a transaction responsive to at least one HTML format document that is received by the browser. However, claim 3 of Richards differs since it recites additional elements including a server, wherein at least one markup language document is accessible through the server and a display device. It is known in the art that a display device is a component of an automated banking machine. Also, it would have been obvious to a person of ordinary skill in the art to modify Richards by removing the additional features because the present invention and claim 3 of Richards performs a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

21. Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6965879 to Richards et al. ("Richards") Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses operating a browser in at least one computer in connection with an automated banking machine (see step a) , receiving at least one HTML format document (markup language) with the browser, wherein the at least one HTML format document includes at least one transaction instruction (note dispenser) (see step b) and carrying out at least one

transaction function with a transaction function device in the automated banking machine responsive to the at least one HTML format document (see step c).

22. Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6965879 to Richards et al. ("Richards"). Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses an automated banking machine comprising a computer in operative connection with the banking machine (an automated banking machine including at least one computer), at least one transaction function device (note dispenser) in the banking machine adapted to carry out at least a portion of a banking transaction, wherein the computer is adapted to cause at least one banking transaction to be carried out through operation of at least one transaction function device responsive to at least one markup language document (i.e. the machine is operative to carry out note dispensing transactions responsive to markup language documents). However, claim 1 of Richards differs since it recites an additional element, which indicates that the machine dispenses note responsive to receipt of non-HTTP messages. Since the claim recited in Richards and the present invention performs a similar function, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of Richards by removing the additional element. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

23. Claims 13-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6965879 to Richards et al. ("Richards"). Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses an automated banking machine comprising a computer in operative connection with the banking machine (an automated banking machine including at least one computer), at least one transaction function device (note dispenser) in the banking machine adapted to carry out at least a portion of a banking transaction, wherein the computer is adapted to cause at least one banking transaction to be carried out through operation of at least one transaction function device responsive to at least one markup language document, wherein the computer includes document handling software (i.e. browser), and wherein the computer is operative to carry out the at least one banking transaction responsive to the document handling software processing the at least one markup language document, wherein the transaction function device includes a note dispenser, and wherein the at least one banking transaction includes dispensing at least one note from the note dispenser. However, Richards differs since it recites a server, wherein at least one markup language document is accessible through the server. It would have been obvious to a person of ordinary skill in the art to modify Richards by removing the additional features because the present invention and claim 3 of Richards performs a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

24. Claims 16, 17, 22 and 23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6965879 to Richards et al. ("Richards"). Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses providing an automated banking machine including at least one transaction function device (note dispenser), wherein the automated banking machine is in operative connection with at least one computer, processing at least one mark up language document with the computer, carrying out at least a portion of a banking transaction with the transaction function device responsive to processing the at least one markup language document with the computer in step (b), wherein the transaction function device includes a note dispenser, and wherein in step (c) the portion of the banking transaction includes dispensing at least one note with the note dispenser; wherein the banking machine includes at least one output device, and further comprising the step of providing at least one output through the output device responsive to processing at least one mark up language document with the computer; wherein the computer includes browser software, and wherein in step (d) the at least one output is provided responsive to the browser software processing the at least one mark up language document. However, Richards differs since it recites a server, wherein at least one markup language document is accessible through the server. It would have been obvious to a person of ordinary skill in the art to modify Richards by removing the additional features because the present invention and claim 3 of Richards performs a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963).



Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

25. Claim 16 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6965879 to Richards et al. ("Richards"). Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses providing an automated banking machine including at least transaction function device (i.e. note dispenser), wherein the automated banking machine is in operative connection with at least one computer (an automated banking machine including at least one computer), processing at least one mark up language document with the computer and carrying out at least a portion of a banking transaction with the transaction function device responsive to processing the at least one mark up language document with the computer in step (b). However, claim 1 of Richards differs since it recites an additional element, which indicates that the machine dispenses note responsive to receipt of non-HTTP messages. Since the claim recited in Richards and the present invention performs a similar function, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of Richards by removing the additional element. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.
26. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6539361 to Richards et al. ("Richards").

Although the conflicting claims are not identical, they are not patentably distinct from each other because Richards discloses an automated teller machine (i.e. automated banking machine) that operates to conduct at least one financial transaction responsive to at least one mark-up language document (i.e. wherein the machine is operative to provide outputs through the display device responsive to markup language documents processed responsive to operation of the note dispenser). Claim 2 of Richards differs since it recites additional elements including "a display device, a note dispenser, at least one computer in operative connection with the note dispenser and the display device, wherein the machine is operative to operate the note dispenser responsive to non-HTTP messages received from a remote host." It is known in the art that an automated banking machine includes a display device and a note dispenser. Also, since the claim recited in Richards and the present invention performs a similar function, it would have been obvious to a person of ordinary skill in the art to modify claim 2 of Richards by removing the additional element. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

27. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 7062464 to Drummond et al. ("Drummond") Although the conflicting claims are not identical, they are not patentably distinct from each other because Drummond discloses an automated teller machine (i.e. automated transaction machine) that operates to conduct at least one financial transaction responsive to at least one mark-up

language document (wherein the computer is operative responsive to the one HTML document to operate the output device). Claim 9 of Drummond differs since it recites additional elements; however, since the claim recited in Drummond and the present invention performs a similar function, it would have been obvious to a person of ordinary skill in the art to modify claim 9 of Drummond by removing the additional element. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

28. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6289320 to Drummond et al.

("Drummond") Although the conflicting claims are not identical, they are not patentably distinct from each other because Drummond discloses an automated teller machine (i.e. automated transaction machine) that operates to conduct at least one financial transaction responsive to at least one mark-up language document (software executable in the computer, the software including a browser, wherein the software is operative to cause the computer to access at least one HTML document address with the browser, wherein the document includes at least one document instruction therein; wherein the computer responsive to the dispense instruction causes the sheet dispenser to operate to dispense sheets.). Claim 1 of Drummond differs since it recites additional elements; however, since the claim recited in Drummond and the present invention performs a similar function, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of Drummond by removing the additional element. It is well settled that the

omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

29. Claims 1 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6289320 to Drummond et al. ("Drummond"). Although the conflicting claims are not identical, they are not patentably distinct from each other because Drummond discloses an automated banking machine (i.e. automated transaction machine) including a transaction function device, wherein the transaction device is selectively operative to carry out a transaction function, a computer in operative connection with the transaction function device, software executable in the computer, wherein the software includes a browser, wherein the browser is operative to process HTML documents including instructions therein, and wherein the transaction function device is operative to carry out the transaction function responsive to the browser processing at least one document including at least one instruction adapted to cause the computer to cause operation of the transaction function device, wherein the software is operative responsive to an instruction to access at least one HTTP record address, wherein the at least one HTTP record address corresponds to at least one HTTP record including instructions adapted to cause the computer to cause operation of the transaction function device. Drummond (6289320) differs since it does not recite an output device and input device; however, these are inherent features. It is known in the art that an automated banking machine includes an output device and an input device.

30. Claim 8 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 31 of copending Application No. 09077337.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09077337 discloses an automated teller machine (an automated banking machine) comprising a computer, a browser operating in the computer, a transaction function device(a sheet dispenser mechanism) in operative connection with the computer, wherein the computer is operative to cause the transaction function device to carry out a transaction function responsive to at least one HTML format document that is received by the browser (wherein the sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser, to dispense at least one sheet form the automated banking machine).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

31. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31 and 48 of copending Application No. 09077337.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09077337 discloses an automated teller machine (i.e. automated banking machine) that operates to conduct at least one financial transaction responsive to at least one mark up language document (a sheet dispenser mechanism in operative connection with the computer, wherein the sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser, to dispense at least one sheet from the automated banking machine). Application No. 09077337 differs because it recites additional elements including a computer, a browser operating in the computer and a sheet dispenser mechanism. It

is known in the art that automated teller machines include a sheet dispenser mechanism. Also, since the present invention and the claim recited in 09077337 perform similar functions, it would have been obvious to a person of ordinary skill in the art to modify claim 31 of Application No. 09077337 by removing the additional elements. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

32. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 38 and 50 of copending Application No. 09077337. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09077337 discloses an automated teller machine (i.e. automated banking machine) that operates to conduct at least one financial transaction responsive to at least one mark-up language document (wherein the computer is operative responsive to the at least one HTML document to enable the sheet dispenser to dispense at least one sheet from the automated banking machine). Application No. 09077337 differs because it recites additional elements; however, since the present invention and the claim recited in 09077337 perform similar functions, it would have been obvious to a person of ordinary skill in the art to modify claims 31 and 50 of Application No. 09077337 by removing the additional elements. It is well settled that the omission of an element and its function is an obvious expedient if the

remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

33. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 51-54 of copending Application No. 09077337.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09077337 discloses an automated teller machine (i.e. automated banking machine) that operates to conduct at least one financial transaction responsive to at least one mark-up language document (i.e. a computer, wherein the computer is adapted to receive at least one mark up language document, and wherein the computer is adapted to operate responsive to the at least one mark up language document to cause at least one sheet to be dispensed from the automated banking machine).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

34. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 55 of copending Application No. 09233249.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09233249 discloses an automated teller machine (ATM) that operates

to conduct at one financial transaction responsive to at least one mark-up language document (wherein the second set of XML tags specifies a second event processor further comprising: operating a second transaction function device on the ATM responsive to the second event processor).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

35. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10980209.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10980209 discloses an automated teller machine (automated banking machine) that operates to conduct at least one financial transaction responsive (at least one device) to at least one mark-up language document.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

36. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 21 and 22 of copending Application No. 09578291.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09578291 discloses an automated teller machine (banking machine) that operates to conduct at least one financial transaction responsive to at least one mark up language document (wherein the transaction function device includes a sheet dispenser, and wherein the document includes at least one sheet dispenser instruction, and wherein the sheet dispenser is enabled to dispense at least one sheet responsive to the browser processing the



document). The claims differ since claims 21 and 22 recite additional features including process at least one document from the institution server; however, since the present invention and the claim recited in Application no. 09578291 perform similar functions, it would have been obvious to a person of ordinary skill in the art to modify claims 21 and 22 of Application No. 09578291 by removing the additional element. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

37. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 25 and 26 of copending Application No. 09578291. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09578291 discloses an automated teller machine (automated banking machine) that operates to conduct at least one financial transaction responsive to at least one mark up language document (wherein the computer is adapted to enable the transaction function device to operate responsive to the device instructions; wherein the transaction function device includes a note dispenser). The claims differ since claims 25 and 26 recite additional features including; however, since the present invention and the claim recited in Application no. 09578291 perform similar functions, it would have been obvious to a person of ordinary skill in the art to modify claims 25 and 26 of Application No. 09578291 by removing the additional

element. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

38. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 26-28 of copending Application No. 09639310. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09639310 discloses an automated teller machine (ATM) that operates to conduct at least one financial transaction responsive to at least one mark-up language document (wherein the at least one markup language document includes at least one instruction adapted to cause operation of at least one banking transaction function device associated with carrying out a banking transaction function corresponding to the selection, wherein the at least one markup document is accessed via the Internet and includes a currency dispense instruction operative to cause operation of the currency dispenser).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

39. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-7 of copending Application No. 10357145. Although the conflicting claims are not identical, they are not patentably distinct from each other

because Application No. 10357145 discloses an automated teller machine (ATM) that operates to conduct at least one financial transaction responsive to at least one mark-up language document (wherein the at least one ATM application when accessed remotely by at least one ATM including a cash dispenser, is operative to cause ATM instructions to be delivered from the at least one server to the at least one ATM, the ATM instructions include markup language instructions) .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

40. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10430123. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10430123 discloses an automated teller machine (automated banking machine) that operates to conduct at least one financial transaction responsive to at least one mark-up language document (dispensing cash from an automated banking machine to a user responsive to at least one instruction included in at least one markup language document). Application No. 10430123 differs since it recites an additional limitation (see step (b)). However, this application and Application No. 10430123 perform similarly functions; therefore, it would be obvious to modify Application No. 10430123 by eliminating the additional elements. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

41. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21, 23 of copending Application No. 10957287. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10957287. Application No. 10957287 discloses an automated teller machine (ATM) that operates to conduct at least one financial transaction responsive to at least one markup language document (responsive to processing the markup language operating the first automated banking machine to allow a user to receive cash through operation of the cash dispenser)

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

42. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 34 of copending Application No. 11226104. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 11226104 discloses an automated banking machine that operates to conducts at least one financial transaction responsive to at least one mark-up language document (operating the cash dispenser responsive to processing at least one markup language document).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

43. Claim 12 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-38 of copending Application No. 11226540.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 11226540 discloses an automated teller machine (automated banking machine) that operates to conduct at least one financial transaction responsive to at least one markup language (the computer is operative to cause at least one of the transaction function devices to operate responsive to at least one instruction in at least one document processed by least one of the browsers).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 112***

44. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

45. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because this is a “single means claim”. “A means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those known to the inventor” (see MPEP 2164.08(a). Further, there are not distinct functions that make the device of claim 12 an ATM.

***Claim Rejections - 35 USC § 103***

46. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

47. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5650605 to Morioka et al. in view of U.S. Patent No. 5742845 to Wagner.

Morioka et al. disclose an ATM that operates to conduct at least one financial transaction. The ATM as shown in fig. 4 includes a card reader/writer 41, a printer 43, keyboards 60,62, a bill handling section BRU, a coin handling section CRU. Further, as seen in fig. 5, the ATM can perform withdraw, deposit, passbook and balance check transactions as indicated at steps S11-S14 respectively, responsive to communication with a host or center controller, see e.g. fig. 5 step S20, col. 18 lines 20-26 and the “center or terminal controller” in fig. 4. Morioka et al. do not expressly disclose that the financial transaction is responsive to at least one mark-up language document. Wagner discloses that in some ATM systems, the ATMs are coupled to the central processing system through dedicated telephone or communication lines that are expensive with a high communication cost per transaction (see col. 1 line 58 to col. 2 line 3). Wagner further teaches that each financial transaction system typically employs its own proprietary communication protocol and data formats between devices and that communication software thus absorbs a significant amount of terminal resources that could be used to support

other terminal operations (see col. 2 lines 25-47). In light of at least these above-mentioned concerns, Wagner teaches in an analogous art that a financial transaction is responsive to at least one mark-up language document in a transaction system. More specifically, Wagner teaches communicating with “non-standard I/O devices”, e.g. PIN pad, card reader, printer, in a transaction system via a Web server (see col. 9 line 56 to col. 10 line 51). The communication further involves HTML (mark-up language) files including tags that the above-mentioned devices are responsive to (see col. 11 lines 5-54 and col. 15 line 64 to col. 16 line 12). Wagner teaches that these Internet protocols provide the advantage of standardized communication (see col. 3 lines 30-39). Thus, it would have been obvious to those of ordinary skill in the art at the time of the invention to modify the teachings of Morioka et al. to modify the financial transaction of Morioka et al. to be responsive to a mark-up language document as taught by Wagner, who employs similar card reader, printer and keyboard devices, for the advantages of using a standardized communication protocol and to cure the deficiencies involved in using dedicated lines and proprietary protocols as mentioned above.

### *Conclusion*

48. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 4,091,448 to Clausung
- US Patent No. 5,220,501 to Lawlor
- US Patent No. 5,539,825 to Akiyama
- US Patent No. 5,619,558 to Jheeta
- US Patent No. 5,642,485 to Deaton
- US Patent No. 5,761,662 to Dasan
- US Patent No. 5,915,246 to Patterson
- US Patent No. 5,974, 451 to Simmons
- US Patent No. 6,304,860 to Martin
- US Patent No. 5,546,523 to Gatto

- US Patent No. 7062464 to Drummond et al.  
US Patent No. 5802299 to Logan et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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